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EXAMINER

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ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/714,786

Applicant(s)

ARBUCKLE ET AL.

Examiner

Stephen M Gravini

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 16-102 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to a subcombination method, classified in class 705, subclass 14.
- II. Claims 16-28 and 37-41, drawn to a subcombination method, classified in class 705, subclass 1.
- III. Claims 29-35, drawn to a subcombination method, classified in class 705, subclass 10.
- IV. Claim 36, drawn to a subcombination method, classified in class 709, subclass 218.
- V. Claims 42-49, drawn to a combination method, classified in class 705, subclass 50.
- VI. Claims 50-60, drawn to a subcombination method, classified in class 707, subclass 1.
- VII. Claims 61-77, drawn to a subcombination method, classified in class 707, subclass 500.
- VIII. Claims 78-89, drawn to a subcombination method, classified in class 709, subclass 100.
- IX. Claims 90-102, drawn to a subcombination apparatus, classified in class 705, subclass 400.

Art Unit: 3622

The inventions are distinct, each from the other because of the following reasons:

Inventions of group I and groups II-IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group I has separate utility such as first, second, and third, graphical positions being located in their respective positions on the graphical layout page to create a second graphical configuration, the visual impression conveyed by the second graphical configuration to the computer user, when the first, second, and third graphical images are placed in the first graphical position, the second graphical position, and the third graphical position, respectively is recognized as the first graphical configuration by the computer user when the graphical layout page is viewed on a video display, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Inventions of group II and groups I & III-IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group II has separate utility such as first, second, and third, graphic images being positioned on the graphical layout page such that all of the graphical information presented on the first page is also presented on graphical layout page to the computer user when the graphical layout page is viewed on a video display, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Inventions of group III and groups I, II, & IV-IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct

Art Unit: 3622

from each other if they are shown to be separately usable. In the instant case, invention of group III has separate utility such as displaying the graphical and textual material in a visually perceptible manner to the computer user such that the computer user perceives the graphical and textual material on a display in substantially the same arrangement which they appear on the at least one page in the printed publication, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Inventions of group IV and groups I-III & V-IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group IV has separate utility such as presenting advertising material which appears in a printed publication to a computer user as defined in claim wherein the step of transmitting the first computer file comprises the step of transmitting the first computer file to the computer user via a TCP/IP protocol, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Inventions of group V and groups I-IV & VI-IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group V has separate utility such as preparing and storing promotional material into a file and manipulating the file for creating a digital image for computer database entry and providing web user access to the promotional material, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Art Unit: 3622

Inventions of group VI and groups I-V & VII-IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group VI has separate utility such as providing and directing computer users to geographic locations for promotional material then offering and directing and displaying the promotional material, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Inventions of group VII and groups I-VI & VIII-IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group VII has separate utility such as providing and directing computer users to geographic locations for promotional material then providing only the promotional material for a selected geographical location, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Inventions of group VIII and groups I-VII & IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group VIII has separate utility such as providing and directing computer users to geographic locations for promotional material along with a listed of categories of the promotional material then providing and directing a desired category of the promotional material, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Art Unit: 3622

Inventions of group IX and groups I-VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group IX has separate utility such as means for providing and directing computer users to geographic locations for promotional material then providing the promotional material, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since the restriction is complex and examiner knows from past experience that an election will not be made by telephone, this written restriction is proper under MPEP 812.01.

Normal Office practice does not permit amendments to be made in response to an outstanding election/restriction requirement. Please see MPEP 819 and 820. However in this case, the amendment simplifies the invention under examination and clarifies numerous multiple dependent claim issues and therefore will advance prosecution such that the amendment is permitted. The restriction requirement above has been amended to clarify the claims considered independent and distinct for each grouped embodiment. Applicant's election with traverse of elected group I in Paper No.

Art Unit: 3622

5 is acknowledged. Since the traversal is not argued, the requirement is still deemed proper and is therefore made FINAL.

Requirements for Information

37 CFR 1.105 states: (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (i) Commercial databases : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- (ii) Search : Whether a search of the prior art was made, and if so, what was searched.
- (iii) Related information : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- (iv) Information used to draft application : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

Art Unit: 3622

(v) Information used in invention process : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements : Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vii) of this section may also be applied to such assignee.

(3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section

will be governed by §§ 1.135 and 1.136.

Art Unit: 3622

The Office is requiring submission of information reasonably necessary to properly examine and treat the claimed subject matter under Rule 105. Of particular interest is information used in drafting the present operation including information related to the field of endeavor or business practices used by applicants' professional business ventures, to show the information used in the invention process, and identification of any use of the claimed invention known to the inventor at the time the application was filed notwithstanding the date of the use. Since the application is filed as a small entity status, along with the fact that the assignee has at least one trademark demonstrating the claimed invention is well defined in the stream of commerce and no information disclosure statement has been filed, it appears that it would be appropriate to require the applicants to provide information necessary to ensure a quality examination may be performed by the Office.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C.

Art Unit: 3622

§101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete, and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998). Together, the "technological arts" and "useful, concrete, and tangible result" judicial review standard, result in a comprehensive examination standard wherein the "technological arts" is one element and the "useful, concrete, and tangible result" is another complementary element.

This comprehensive examination standard was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful,

Art Unit: 3622

concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. The Board of Patent Appeals and Interferences (BPAI) have recently acknowledged this dichotomy in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BPAI 2001).

Claims 1-15 are rejected under 35 U.S.C. 101 because the independently claimed invention does not recite a useful, concrete, and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998) such that the claimed invention is within the technological arts under *In re Waldbaum* 173 USPQ 430 (CCPA 1972) wherein the phrase "technological arts" is synonymous with "useful arts" as it

Art Unit: 3622

appears in Article I, Section 8 of the United States Constitution. In this claim, it is considered that a concrete and tangible result is not recited. Specifically, the recitation of selecting a first printed publication or the recitation of preparing a graphic image are considered not to produce a concrete result because a result cannot be assured or is not reproducible. The selecting and preparing recitations are considered an abstract concept that is non-enabling because it is unclear how one would select and prepare the subject matter which applicant considers the patentable invention. Furthermore, under *In re Wamerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994), the selecting and preparing recitations are considered intangible because those steps are simply an abstract construct, such as a disembodied data structure and a method of making it, wherein those recitations involve more than a manipulation of an abstract idea and therefore is non-statutory under 35 USC 101. Because the independently claimed invention does not recite a useful, concrete, and tangible result, such that it is considered not within technological arts so that it uses technology in a non-trivial matter. Finally under *Ex parte Bowman*, 61 USPQ2d 1665 (Bd. Pat. App. & Inter. 2001) (unpublished but cited for analysis rather than precedent), in which an invention disclosed and claimed directed to a human merely making mental computations and manually plotting results on a paper chart is nothing more than an abstract idea which is not tied to any technological art and is not a useful art as contemplated by the United States Constitution. In this independently claimed invention, the steps of selecting a first printed publication and preparing a graphic image are considered nothing more than an abstract idea since it is not tied to any technological art. However in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim recitations including selecting a first printed publication and preparing a graphic image are considered non-enabling because it is considered to be described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. It is considered that the specification does not illustrate or give concrete examples of how the selecting and prepare steps are performed. However, for discussion under the prior art, examiner will assume that those claims are enabling.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims reciting selecting a first printed publication and preparing a graphic image are considered indefinite because it is

Art Unit: 3622

unclear from the claims how the selecting and preparing steps are performed.

Furthermore, the recited "QUARK XPRESS," "HTML," and "XML" render the claims indefinite because each is a federally registered trademark. However, for discussion under the prior art, examiner will assume that those claims are not indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rohen (US 5,186,629) or Herz et al. (US 5,835,087) and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Rhoads (US 6,122,403).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3622

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over examiner's personal experience with operating a copy machine for photostatic copies, such as information disclosure statements for inclusion into Office actions. The claimed computer, video display, computer user click, HTML code, digital file including tiff, jpeg, gif, and bmp, TCP/IP protocol, world wide web, QUARK XPRESS, and XML or markup language are considered automated features of an old and well known manual operation, which will also be discussed infra. The claimed invention under examiner experience is based on the broadest reading of the claims under the *Graham* decision. Since at least 1995, examiner has experienced photocopying a paper, which has performed the claimed method comprising:

selecting a first printed publication, the first printed publication including a first page located somewhere in the first printed publication without regard to the order of pages

Art Unit: 3622

within the printed publication, the first page having a first graphical configuration, the first graphic configuration comprising:

- a first graphic image positioned in a first location on the first page;

- a second graphic image positioned in a second location on the first page;

- a third graphic image positioned in a third location on the first page;

preparing a graphical layout page adapted for display, the graphical layout comprising:

- a first graphical position located in a position on the graphical layout page which corresponds to the first location on the first page;

- a second graphical position located in a position on the graphical layout page which corresponds to the second location on the first page;

- a third graphical position located in a position on the graphical layout page which corresponds to the third location on the first page;

the first, second, and third graphical positions being located in their respective positions on the graphical layout page to create a second graphical configuration, the visual impression conveyed by the second graphical configuration to the computer user, when the first, second, and third graphical images are placed in the first graphical position, the second graphical position, and the third graphical position, respectively, is recognized as the first graphical configuration when the graphical layout page is viewed are part of examiner's personal experience. Examiner's personal experience also includes the claimed newspaper, magazine, and advertising supplement, plurality of pages, enlarged graphical images, sale product, searchable information, upper or lower

Art Unit: 3622

and/ or right or left positions, and directing geographic locations. The claimed feature of selecting a first printed publication, the first printed publication including a first page located somewhere in the first printed publication without regard to the order of pages within the printed publication, the first page having a first graphical configuration is considered functionally equivalent to examiner selecting a page or pages to be copied, such as a multiple paged information disclosure statement within a patent application. The claimed first graphic image positioned in a first location on the first page, second graphic image positioned in a second location on the first page, and third graphic image positioned in a third location on the first page is considered functionally equivalent to an information disclosure statement including a box including an inventor's name (first graphic image), a box including an application serial number (second graphic image), and box for reference identification (third graphic image). The claimed step of preparing a graphical layout page adapted for display is considered equivalent to examiner positioning an item to be copied properly on a glass screen of a photostatic copy machine. The claimed a first graphical position located in a position on the graphical layout page which corresponds to the first location on the first page, a second graphical position located in a position on the graphical layout page which corresponds to the second location on the first page, a third graphical position located in a position on the graphical layout page which corresponds to the third location on the first page is considered equivalent to a resulting copy which displays an information disclosure statement including a box including an inventor's name (first graphical position), a box including an application serial number (second graphical position), and box for

Art Unit: 3622

reference identification (third graphical position). The claimed first, second, and third graphical positions being located in their respective positions on the graphical layout page to create a second graphical configuration, the visual impression conveyed by the second graphical configuration to the computer user, when the first, second, and third graphical images are placed in the first graphical position, the second graphical position, and the third graphical position, respectively, is recognized as the first graphical configuration when the graphical layout page is viewed is considered functionally equivalent to examiner verifying that the copy made from the photocopy machine matches the original place on the machine. The claimed newspaper, magazine, and advertising supplement, plurality of pages, enlarged graphical images, sale product, searchable information, upper or lower and/ or right or left positions, and directing geographic locations are also included in examiner's experience. The claimed invention contains automated features, such as computer, video display, computer user click, HTML code, digital file including tiff, jpeg, gif, and bmp, TCP/IP protocol, world wide web, QUARK XPRESS, and XML or markup language which are obvious automated variations to the examiner's experience such that the examiner will use Official notice to obviate that claimed subject matter. The computer, video display, computer user click, HTML code, digital file including tiff, jpeg, gif, and bmp, TCP/IP protocol, world wide web, QUARK XPRESS, and XML or markup language, as claimed, are interpreted to encompass automated electronic communications associated with electronic mail, Internet, and/or computer to server communications that have been performed by examiner using manual or semi-automated means incorporating manual means of the

Art Unit: 3622

presently claimed automated invention. The claimed invention, recited by the applicant, is considered to have been provided to examiner by personal experience long before the filing of applicant's invention. Those terms are merely modern terms for the method used to carry out the functionality of the claimed invention. More specifically the claimed computer, video display, computer user click, HTML code, digital file including tiff, jpeg, gif, and bmp, TCP/IP protocol, world wide web, QUARK XPRESS, and XML or markup language are considered modern day terms in describing automated mailing of information disclosure statements such that examiner may no longer need to walk to a photostatic copier, copy an applicants' information disclosure statement, and include the copy in the Office action. Examiner notes that it is old and well known to those skilled in the art of the claimed method, that it would have been obvious to claim the invention as recited by the applicants, in order to overcome the explicit teachings of examiner's personal experience discussed supra. It would have been obvious to one skilled in the art to provide the automated claimed method since those features, particularly computer, video display, computer user click, HTML code, digital file including tiff, jpeg, gif, and bmp, TCP/IP protocol, world wide web, QUARK XPRESS, and XML or markup language are merely automated features of a concept that is old and well known.

Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. The motivation to combine applicants' claimed invention with the services offered by examiner's experience of photostatic copying is to allow greater consumer

Art Unit: 3622

information targeting capabilities through electronic mediums, while transferring information, which clearly shows the obviousness of the claimed invention. One would also be motivated to combine the teachings of examiner's experience with current computer and network innovations available such that much of examiner's duties can be carried out in a more efficient manner through computer technology than manually using a photostatic copy machine. One would be further motivated to combine the information in the form of advertisements with the information disclosure statements such that applicants would no longer need to wait for the postal mailing of an information disclosure statement but rather receive the advertisement-type material electronically on a computer through e-mail or world wide web communications.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The most relevant foreign reference is considered Scroggie et al. (WO 97/23838) while the most relevant non-patent literature reference is considered reference U cited by the examiner in this action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose voice telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov".

Art Unit: 3622

Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.**

Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The facsimile transmission telephone numbers for TC-3600 are:

After-final (703) 872-9327

Official (703) 872-9306

Non-Official/Draft (703) 872-9325


STEPHEN GRAVINI

PRIMARY EXAMINER

smg

February 18, 2004